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7/13/07

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1901 NORTH FORT MYER DRIVE  
SUITE 501  
ARLINGTON, VA 22209

*In re* Application of:  
MacLean, David R.  
Serial No.: 09/550,049  
Filed: April 14, 2000  
Docket: 0100/0091

Title: SAFETY DEVICE FOR USE WITH A  
VIAL

DECISION ON PETITION

This is a decision on the petition filed on March 15, 2007 seeking to either allow the case or forward the case to the Board of Patent Appeals and Interferences for adjudication. This petition is being considered pursuant to 37 CFR §1.181. No fee is required for this petition.

The petition is dismissed.

In the petition, the petitioner requests that the examiner close prosecution by either allowing the claims or forwarding the application to the Board of Patent Appeals and Interferences.

The record shows that:

- 1) On November 5, 2002 the examiner mailed a Non-Final Office Action rejecting claims 1-6 and withdrawing claims 7-21 from further consideration.
- 2) On January 30, 2003, the applicant filed an amendment in response to the November 5, 2002 Office Action.
- 3) On May 6, 2003 the examiner mailed a second Non-Final Office Action.
- 4) On August 5, 2003, the applicant filed an amendment in response to the May 6, 2003 Office Action.
- 5) On October 22, 2003, the examiner mailed a Final Office Action rejecting all pending claims
- 6) On January 13, 2004, the applicant filed an amendment after final.
- 7) On February 2, 2004, the examiner issued an Advisory Action allowing claims 1-6, but maintained the rejection of claims 22-27.
- 8) On February 5, 2004, the applicant filed a response to the Feb. 2, 2004 Advisory Action along with a one-month extension of time.

- 9) On February 17, 2004, the examiner issued a second Advisory Action again maintaining the rejection of claims 22-27.
- 10) On February 20, 2004, the petitioner filed a notice of appeal followed with an appeal brief on April 15, 2004, appealing the final rejection of claims 22-27.
- 11) On December 13, 2004, the examiner reopened prosecution by issuing a Final Office Action maintaining the rejection of claims 22-27 and allowing claims 1-6.
- 12) On February 11, 2005, the petitioner filed a request for reinstatement of the appeal along with a supplemental appeal brief.
- 13) On March 7, 2005, the examiner again issued a Final Office Action allowing claims 1-6 and maintaining the rejection of claims 22-27.
- 14) On March 22, 2005, the applicant filed a second supplemental appeal brief.
- 15) On May 24, 2006, the examiner mailed a third Non-final Office Action rejecting all claims.
- 16) On September 13, 2006, the petitioner filed another request for reinstatement of appeal along with another appeal brief.
- 17) On December 18, 2006, the examiner mailed a fourth Non-Final Office Action, allowing claims 1-6 and maintaining the rejection of claims 22-27.
- 19) On March 15, 2007 the present petition was filed along with another appeal brief.

### Discussion and Analysis

#### 37 CFR § 1.104(b) states:

The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

#### 37 CFR § 1.181(a)(1) states:

Petition may be taken to the Director: (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

Office policy requires examiners to complete a thorough prior art search, and avoid piecemeal examination as much as possible<sup>1</sup>. Regrettably due to late discovery of prior art, prosecution of the applicant's invention has been unavoidably prolonged. Petitions to the director are generally directed to correct procedural errors and not to the merits of the case. Petitions may be taken to the director for non-appealable issues in accordance with 37CFR § 1.181(a). The issue regarding the rejection of claims 22- 27 is appealable and should therefore properly be taken up with the Board of Patent Appeals and Interferences. Moreover, it is the Primary Examiner's duty to consider the merits of the claims under M.P.E.P. §1004. Because this matter is appealable, it does not fall within the Director's discretion in accordance with 37 CFR §1.181. Under the circumstances, the requested relief of allowing the application cannot be granted by petition.

However, in response to this petition, the examiner is hereby directed to timely set up an appeal conference under M.P.E.P. §1207.01. Additionally, the examiner is instructed to expediently

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<sup>1</sup> M.P.E.P. § 707.07(g) states: "Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, how-ever, undue multiplication of references."

proceed with the examination of the application while also taking into consideration Office policy discouraging piecemeal prosecution under M.P.E.P. §707.07(g). Finally, in order to avoid re-opening prosecutions, the examiner is reminded to perform a complete and thorough search of prior art considering not only the claims presented, but also any subject matter the examiner reasonably anticipates might be incorporated into a subsequent amendment in accordance with M.P.E.P. 904.03<sup>2</sup>.

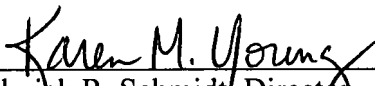
With regards to the petitioner's concern about the reduced term of any potentially issued patent, the petitioner may file a petition requesting the patent term adjustment, if appropriate, after receipt of a Notice of Allowance.

#### Conclusion

For the forgoing reasons, the relief requested by the petitioner will not be granted, because such relief is not the type which can be granted by petition.

The application is being forwarded to the Supervisory Patent Examiner in Art Unit 3767 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR §1.181(f). No extension of time under 37 CFR §1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR §1.181". Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION IS DISMISSED

  
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for Frederick R. Schmidt, Director  
Technology Center 3700

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<sup>2</sup> M.P.E.P. § 904.03 states in relevant part: "It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment."